



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,450	04/03/2001	William Wheeler	L0562/7015	1789

23628 7590 03/24/2004

WOLF GREENFIELD & SACKS, PC  
FEDERAL RESERVE PLAZA  
600 ATLANTIC AVENUE  
BOSTON, MA 02210-2211

EXAMINER

MCCLELLAN, JAMES S

ART UNIT PAPER NUMBER

3627

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/825,450

Applicant(s)

WHEELER ET AL.

Examiner

James S McClellan

Art Unit

3627

MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 10/03/03 has been considered by the examiner. A signed copy of the PTO-1449 is attached.

### ***Specification***

2. The disclosure is objected to because of the following informalities: on page 5, line 10, “?” should be deleted.

Appropriate correction is required.

### ***Drawings***

3. It is noted that Applicant submitted informal drawings on 7/23/01.

### ***Claim Objections***

4. Claim 6 is objected to because of the following informalities: claim 6 improperly depends from itself. For purposes of compact prosecution, the Examiner assumed that claim 6 depends from claim 1. Appropriate correction is required.

Additionally, it is noted that claims 31 and 32 currently depend from claim 28. However, it appears that claims 31 and 32 should depend from claim 29. For purposes of compact prosecution, the Examiner will examine claims 31 and 32 as being dependent on claims 28 and

Art Unit: 3627

29. Once Applicant verifies the intended dependency of claims 31 and 32, the secondary rejection will be withdrawn.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 29-31 and 47-49 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,278,936 (hereinafter “Jones”).

Jones discloses a method and system for uses of a mail system to selectively track movements of items through the system (see column 6, lines 9-23) including: each user entering preferences as to selected conditions under which the user is receive electronic messages concerning an item (see column 8, lines 40-67); the system tracking movement of items through the system (see column 6, lines 9-23); and the system sending an e-mail status message to the user when one of the user preferences conditions is satisfied (see column 8, lines 56-58 and column 9, lines 47-49). Jones sends automatically sends a message when the item is delivered. The recipient can query the system related to items (see column 3, lines 3-5).

Art Unit: 3627

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 32 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Official Notice.

Jones fails to explicitly disclose the sender queries regarding item status.

The Examiner takes Official Notice that is old and well known at the time the invention was made for senders (for example, retailers) to query package delivery couriers as the location and status of the packages they mailed to customers.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Jones with sender status updates as is well known in the art, because providing the sender with status update queries allows the sender to better serve their customers by actively participating in the delivery process.

9. Claims 1-10, 12-28, 33-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,156,988 (hereinafter "Baker") in view of Jones.

Baker discloses a method and system for managing movement of interoffice items: the system generating and storing a record for each item (see column 4, lines 57-61); a bar code tag for each item be utilized at selected points in transport (see column 1, line 45); the system checks for the most current address using a directory and forward the item to that location (see column

Art Unit: 3627

4, lines 29-41); and mail codes from outside mail rooms are accessed (see column 3, lines 33-37).

Baker fails to explicitly disclose user queries related to item tracking and corresponding item status information related to user defined preferences.

As set forth above, Jones discloses user queries related to item tracking and corresponding item status information related to user defined preferences (see column 8, lines 40-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Baker with user tracking capabilities as taught by Jones, because allowing a user to track items will enhance the users knowledge of upcoming deliveries, wherein the user can better anticipate activities related to the delivered item.

10. Claims 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker in view of Jones as applied to claims 1, 9, 13, 33 above, and further in view of Official Notice.

Regarding claim 11, the Examiner takes Official Notice that is old and well known to notify a mail room when an item is delivered (for example, item confirmation).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Baker/Jones with mail room notification as is well known in the art, because providing the mail room with delivery confirmation allows them to track the successfulness of their delivery.

If it is determined that Baker fails to disclose the limitations of claim 17, then the Examiner takes Official Notice that user defined forwarding address usage is old and well known.

Art Unit: 3627

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Baker/Jones with mail forwarding as is well known in the art, because mail forwarding allows items to be delivered when customers have moved locations.

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Tilles is cited of interest for disclosing a a modular mail processing method and system.

Frisbey is cited of interest for disclosing a postal automated delivery system.

Fisher is cited of interest for disclosing a method for supplying automatic status updates using electronic mail.

Byford is cited of interest for disclosing a parcel trace system.

Brisebois is cited of interest for disclosing a cross-media notification system for e-commerce.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Application/Control Number: 09/825,450

Page 7

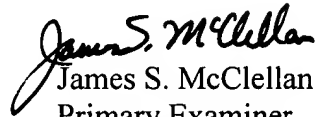
Art Unit: 3627

Commissioner of Patent and Trademarks  
Washington D.C. 20231

or faxed to:

(703) 872-9306 (Official communications) or  
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA, 7<sup>th</sup> floor receptionist.

  
James S. McClellan  
Primary Examiner  
A.U. 3627

jsm  
March 21, 2004